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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/578,100

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Masahiko Sekimoto

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EXAMINER

LAMB, BRENDA A

ART UNIT

PAPER NUMBER

1713

NOTIFICATION DATE

DELIVERY MODE

06/09/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/578,100	Applicant(s) SEKIMOTO ET AL.	
	Examiner Brenda A. Lamb	Art Unit 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/27/2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-10, 15-17, 19 and 22-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-12, 18, 20 and 21 is/are rejected.
- 7) ☒ Claim(s) 13 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Applicant's election without traverse of invention II (claims 11-14, 18 and 20-21) in the reply filed on 1/27/2010 is acknowledged.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a

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later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 11-12, 18 and 20-21 are rejected under 35 U.S.C. 102(e) as being anticipated by WO 03/105200.

WO '200 teaches process and apparatus holding a substrate (see Figures 5a-5b and page 14 line 4 to page 17 line 6). WO '200 process includes the following steps: supporting a substrate with its front surface facing downward; pressing the substrate against a ring-shaped attraction seal portion by a plurality of pressing mechanisms disposed at locations along the circumferential direction of the substrate, thereby bringing a peripheral portion of the back surface of the substrate into tight contact with the attraction seal portion; and vacuuming the attraction seal portion to hold the substrate. Thus every step of the process as set forth in claim 18 is taught by WO '200. WO'200 apparatus includes the following elements: a substrate holding section for supporting a substrate with its front surface facing downward; and an attraction head provided with an attraction seal for attracting and holding the substrate supported by the substrate holding section while sealing a peripheral portion of the back surface of the substrate in a ring; wherein the substrate holding section is provided with a plurality of pressing mechanisms, disposed at locations along the circumferential direction of the substrate holding section, for contacting a peripheral portion of the front surface of the substrate supported by the substrate holding section and pressing the substrate against the attraction head. Thus every element of the apparatus as set

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forth in claim 11 is taught by WO '200. With respect to claim 20, the same rejection applied to claim 11 is applied here. WO '200 also teaches the apparatus further includes a processing tank for bringing a surface to be processed of a substrate. With respect to claim 21, WO '200 tank is capable of holding an electroless plating solution. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987).

"[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). With respect to claim 12, WO '200 pressing mechanism includes a claw and presses substrate against the attraction head.

Claims 11, 18 and 20-21 are rejected under 35 U.S.C. 102 (e) as being anticipated by Dai et al 2003/0221612.

Dai et al process and apparatus holding a substrate. Dai et al process includes the following steps: supporting a substrate with its front surface facing downward; pressing the substrate against a ring-shaped attraction seal portion by a plurality of pressing mechanisms disposed at locations along the circumferential direction of the substrate, thereby bringing a peripheral portion of the back surface of the substrate into tight contact with the attraction seal portion; and vacuuming the attraction seal portion to hold the substrate. Thus every step of the process as set forth in claim 18 is taught by Dai et al. Dai et al apparatus includes the following elements: a substrate holding section for

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supporting a substrate with its front surface facing downward; and an attraction head provided with an attraction seal for attracting and holding the substrate supported by the substrate holding section while sealing a peripheral portion of the back surface of the substrate in a ring; wherein the substrate holding section is provided with a plurality of pressing mechanisms, disposed at locations along the circumferential direction of the substrate holding section, for contacting a peripheral portion of the front surface of the substrate supported by the substrate holding section and pressing the substrate against the attraction head. Thus every element of the apparatus as set forth in claim 11 is taught by Dai et al. (see paragraph 0077-0079). With respect to claim 20, the same rejection applied to claim 11 is applied here. Dai et al also teaches the apparatus further includes a processing tank for bringing a surface to be processed of a substrate. With respect to claim 21, Dai et al tank is capable of holding an electroless plating solution. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Claims 13-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda A. Lamb whose telephone number is (571) 272-1231. The examiner can normally be reached on Wednesday-Friday and on alternate Mondays and Tuesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton, can be reached on (571) 272-1465. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brenda A Lamb
Primary Examiner
Art Unit 1792

/Brenda A Lamb/

Primary Examiner, Art Unit 1792